APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,385	09/26/2003	Masashi Eguchi	031085	2735

38834 7590 03/20/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036	EXAMINER SIKRI, ANISH

ART UNIT	PAPER NUMBER
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

		Application No.	Applicant(s)
Office Action Summary		10/670,385	EGUCHI ET AL.
		Examiner	**Art Unit**	
		Anish Sikri	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 September 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *1/17/2006 09/26/2003*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement submitted on 4/23/2004 been considered

by the Examiner and made of record in the application file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a
foreign country or in public use or on sale in this country, more than one year
prior to the date of application for patent in the United States.

Claims **1, and 2** are rejected under 35 U.S.C. 102(b) as being anticipated over

Hutton et al. (US Patent 6,108,704).

Consider **Claim 1**, Hutton et al clearly discloses an electronic mail system

comprising: a mail server which transmits and receives an electronic mail (Col 1 Lines

59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16); and means for converting

an electronic mail address of a destination terminal into a network address (Col 1 Lines

59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16); wherein the mail server

obtains the network address by the means for converting by using the electronic mail

address included in the received electronic mail (Col 1 Lines 59-67, Col 2 Lines 1-22,

Col 6 Lines 61-66, Col 7 Lines 1-16), and transmits the electronic mail to the obtained

network address (Col 1 Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-

16). Hutton clearly shows that an electronic mail is transmitted via the network with the

corresponding network address.

Consider **Claim 2**, Hutton et al clearly discloses the electronic mail system

according to claim 1, wherein when the destination terminal is assigned with a network

address (Fig 9, Col 1 Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-

16), the destination terminal notifies the means for converting with the terminal name of

the destination terminal and the network address (Fig 9, Col 10 Lines 46-56), and

updates the network address included in the address conversion data (Fig 8, Col 10

Lines 25-35). Hutton clearly discloses on how the network updates the addresses of

the users, which are logged and updated in the database along with time-stamped email

storage (Fig 8, Col 10 Lines 25-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim **3, 4, 5, 6, 7, 8, 9, 10, 11, 12 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutton et al (US Pat 6,108,704), in view of Ranalli et al (US Patent 6,748,057).

Consider **Claim 3**, Hutton et al in view of Ranalli et al fails to disclose an

electronic mail system according to claim 2, wherein the destination terminal is an

Internet facsimile machine which can carry out an image communication by the Internet.

Nonetheless, Rannali et al clearly discloses electronic mail system wherein the

destination terminal is an Internet facsimile machine, which can carry out an image

communication by the Internet (Rannali et al, Col 7 Lines 35-38, Col 17 Lines 5-9).

Therefore it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to incorporate the use of internet facsimile connected to the

electronic mail system taught by Hutton et al's system, for the purpose of transmitting

information to multiple destinations.

Consider **Claim 4**, Hutton et al in view of Rannali et al clearly discloses an

electronic mail system comprising: an address conversion unit which stores address

conversion data for converting an electronic mail address of a destination terminal into a

network address (Fig 8, Col 10 Lines 25-35); an electronic mail reception unit which

receives electronic mail (Fig 8, Col 10 Lines 25-35), and an electronic mail transmission

unit which transmits the electronic mail to the obtained network address (Fig 9, Col 1

Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16). But Hutton et al in

view of Rannali et al fails to disclose an inquiry unit, which obtains the network address

from the address conversion unit by using an electronic mail address of a destination

terminal included in the received electronic mail. Nonetheless, Rannali et al clearly

discloses an inquiry unit, which obtains the network address from the address

conversion unit by using an electronic mail address of a destination terminal included in

the received electronic mail (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col

6 Lines 25-32). Therefore it would have been obvious to a person of ordinary skill in the

art at the time of the invention was made to incorporate the use of inquiry unit (Rannali

et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32) taught by Rannali et

al in Hutton et al's system, for the purpose of having database of user information

(Rannali et al, Col 6 Lines 35-65, Col 7 Lines 1-30) for users of the systems.

Consider **Claim 5**, Hutton et al fails to disclose electronic mail system according

to claim 4, comprising: a directory server which includes the address conversion unit;

and an electronic mail server which includes the electronic mail reception unit, the

inquiry unit, and the electronic mail transmission unit. Nonetheless, Rannali et al

discloses a directory server according to claim 4, comprising: a directory server which

includes the address conversion unit; and an electronic mail server which includes the

electronic mail reception unit, the inquiry unit, and the electronic mail transmission unit

(Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32). Therefore it

would have been obvious to a person of ordinary skill in the art at the time of the

invention was made to incorporate the use of Directory Server (Rannali et al, Fig 3

LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32) taught by Rannali et al in Hutton

et al's system, for the purpose of having a directory server which aids in providing

unified messaging service which includes directory service, LDAP, fax, and mail etc, to

provide users with different methods of communication.

Consider **Claim 6**, Hutton et al fails to disclose electronic mail system according

to claim 4, wherein the mail server includes the address conversion unit, the electronic

mail reception unit, the inquiry unit, and the electronic mail transmission unit.

Nonetheless, Rannali et al discloses an electronic mail system according to claim 4,

comprising: a directory server which includes the address conversion unit; and an

electronic mail server which includes the electronic mail reception unit, the inquiry unit,

and the electronic mail transmission unit (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5

Lines 50-64, Col 6 Lines 25-32). Therefore it would have been obvious to a person of

ordinary skill in the art at the time of the invention was made to incorporate the use of

Directory Server (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-

32) taught by Rannali et al in Hutton et al's system, for the purpose of having a

electronic mail system which aids in providing unified messaging service which includes

Directory service, LDAP, fax, and mail etc, to provide users with different methods of

communication.

Consider **Claim 7**, Hutton et al in view of Rannali et al discloses an electronic

mail system according to claim 4, wherein it comprises of an updating unit (Fig 8, Col 10

Lines 25-35) which updates the network address included in the address conversion

data by notifying the address conversion unit (Fig 8, Col 10 Lines 25-35) from the

destination terminal with the terminal name of the destination terminal and the network

address when the destination terminal is assigned with a network address (Fig 8, Col 10

Lines 25-35). Hutton et al clearly shows how the system converts the addresses from the messages and its updates its database with the new addresses.

Consider **Claim 8**, Hutton et al fails to disclose the electronic mail system according to claim 4, wherein the address conversion data is a structured document. Nonetheless, Rannali clearly shows that electronic mail system uses a structured document (Rannali et al, Col 6 Lines 24-67, Col 7 Lines 1-29). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the use of structured documents in the system (Rannali et al, Col 6 Lines 24-67, Col 7 Lines 1-29) taught by Rannali et al in Hutton et al's system, for the purpose of data in easy accessible format, and which can be also be used by other various communication methods of the system easily.

Consider **Claim 11**, Hutton et al in view of Rannali et al clearly discloses an electronic mail system according to claim 4, wherein the address conversion unit stores an update time for the address conversion data (Col 6 Lines 55-67, Col 7 Lines 1-16), and when a prescribed period of time elapses from the update time, the address conversion unit requests a network address from the destination terminal (Col 6 Lines 55-67, Col 7 Lines 1-16). Hutton et al clearly shows on how the electronic mail system polls the time on the system for message retrieval which in turn helps the system in its polling.

Consider **Claim 12**, Hutton et al discloses the program for an electronic mail system comprising: a command for storing and managing address conversion data for

converting an electronic mail address of a destination terminal into a network address

(Col 1 Lines 59-67, Col 2 Lines 1-22, Col 6 Lines 61-66, Col 7 Lines 1-16); and a

command for obtaining the network address by referring to the address conversion data

by an electronic mail address (Col 10 Lines 46-56) when receiving an electronic mail of

an electronic mail address, but Hutton et al fails to teach a common for obtaining the

network address by referring to the address conversion data by electronic mail address

when receiving an electronic mail other than that of the mailbox managed by the mail

server. Nonetheless, Rannali et al clearly shows the program for an electronic mail

system comprising: a command for storing and managing address conversion data for

converting an electronic mail address of a destination terminal into a network address

(Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32, Col 7 Lines

35-38, Col 15 Lines 35-40, 42-55); and a command for obtaining the network address

by referring to the address conversion data by an electronic mail address when

receiving an electronic mail of an electronic mail address other than that of the mailbox

managed by the mail server (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col

6 Lines 25-32, Col 7 Lines 35-38, Col 15 Lines 35-40, 42-55). Therefore it would have

been obvious to a person of ordinary skill in the art at the time of the invention was

made to incorporate the use of a command for obtaining the network address from the

LDAP or Directory Service to obtain its network address in the system taught by Rannali

et al in Hutton et al's system for the purpose of obtaining network address from an

electronic mail message with the use of LDAP server or Directory Server.

Consider **Claim 13**, Hutton et al fails to disclose the program for the electronic

mail system according to claim 12, further comprising: a command for the destination

terminal to notify a server that manages the address conversion data of a terminal name

of the destination terminal and a network address when the destination terminal is

assigned with a network address from a server for assigning a network address.

Nonetheless, Rannali et al clearly shows the program for the electronic mail system

according to claim 12, further comprising: a command for the destination terminal to

notify a server that manages the address conversion data of a terminal name of the

destination terminal and a network address when the destination terminal is assigned

with a network address from a server for assigning a network address (Rannali et al, Fig

3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines 25-32, Col 7 Lines 35-38, Col 15 Lines

1-9, Col 16 Lines 4-6). Therefore it would have been obvious to a person of ordinary

skill in the art at the time of the invention was made to incorporate the use of a

command for obtaining notification when the LDAP or Directory Service obtains the

network address (Rannali et al, Fig 3 LDAP-15, Fig 5, Col 5 Lines 50-64, Col 6 Lines

25-32, Col 7 Lines 35-38, Col 15 Lines 1-9, Col 16 Lines 4-6) from the system taught by

Rannali et al in Hutton et al's system for the purpose of notification of events carried out

by the electronic mail system.

Claims **9 and 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over

Hutton et al (US Pat 6,108,704), in view of Ranalli et al (US Patent 6,748,057), and in

further view of. Besprosvan (US Pub 2002/0124057).

Consider **Claim 9**, Hutton et al in view of Rannali et al clearly fails to disclose the

electronic mail system according to claim 4, further comprising: mailboxes for each of

the destination terminals; wherein when there is no mailbox for the destination terminal

included in the received electronic mail, the inquiry unit inquires the network address

from the address conversion unit. Nonetheless, Besprosvan clearly discloses the

electronic mail system according to claim 4, further comprising: mailboxes for each of

the destination terminals (Besprosvan Pg 5, [0057], [0064]); wherein when there is no

mailbox for the destination terminal included in the received electronic mail (Besprosvan

Pg 5, [0055], [0057], [0064]), the inquiry unit inquires the network address from the

address conversion unit (Besprosvan Pg 5, [0057], [0064]). Therefore it would have

been obvious to a person of ordinary skill in the art at the time of the invention was

made to incorporate the use of a mailbox (Besprosvan Pg 5, [0057]) to store messages

in the system along with storing all messages received by the system (Besprosvan Pg

5, [0055]) taught by Besprosvan, Ranali et al in Hutton et al's electronic mail system, for

the purpose of storing messages in mailboxes and even when the LDAP or database

server have no mailbox for users, as the system is designed to store messages when

they are received.

Consider **Claim 10**, Hutton Hutton et al in view of Rannali et al clearly fails to

disclose the electronic mail system according to claim 4, further comprising: mailboxes

for each of the destination terminals; wherein when the inquiry unit fails to obtain the

network address from the address conversion unit by using the electronic mail address

of the destination terminal included in the received electronic mail, the received

electronic mail is stored in the mailbox. Nonetheless, Besprosvan clearly discloses

electronic mail system according to claim 4, further comprising: mailboxes for each of

the destination terminals; wherein when the inquiry unit fails to obtain the network

address from the address conversion unit by using the electronic mail address of the

destination terminal included in the received electronic mail, the received electronic mail

is stored in the mailbox (Besprosvan Pg 5, [0057], [0064]). Therefore it would have

been obvious to a person of ordinary skill in the art at the time of the invention was

made to incorporate the use of mailbox even if the system was not able to connect to

the LDAP to obtain network addresses as the system does is able to provide allocation

of storage resources by the system that provides reference/redirection of messages

(Besprosvan Pg 5, [0055], [0057], [0064]) taught by Besprosvan, Ranali et al in Hutton

et al's electronic mail system, for the purpose of storing messages in mailboxes even

when LDAP or database server is not able to obtain network addresses as the system is

capable of storing all messages which are directed towards it.

Conclusion

Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed**

to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Anish Sikri whose telephone number is (571) 270-1783.

The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Rafael Pérez-Gutiérrez can be reached on (571) 272-7915. The fax phone

number for the organization where this application or proceeding is assigned is (571)

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you
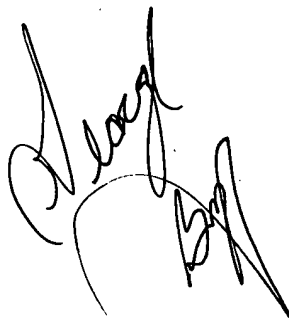
have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist/customer service whose telephone

number is (571) 272-2600.

Anish Sikri
A.S./a.s.

March 15, 2007